

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/796,485 Confirmation No.: 2291
Applicant(s): Stone, et al.
Filed: March 9, 2004
Art Unit: 3687
Examiner: Rudy, Andrew J.
Title: SYSTEMS, METHODS AND COMPUTER PROGRAM PRODUCTS FOR
IMPLEMENTING PROCESSES RELATING TO RETAIL SALES

Docket No.: 940472-267909
Customer No.: 24239

Mail Stop Technology Center 3600
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 35 U.S.C. § 1.181
REQUEST FOR WITHDRAWAL OF FINALITY
UNDER MPEP §§ 1002.02(c)(3)(a) and 706.07(c)**

Sir:

Applicants are in receipt of a final Office Action mailed January 26, 2009, in the above-referenced application. Applicant respectfully submits that the finality of the subject Office Action is premature and therefore requests withdrawal of finality, pursuant to Section 706.07(d) of the Manual of Patent Examining Procedure (MPEP).

I. Timing of Petition

This Petition is filed concurrently with a Notice of Appeal and a Pre-Appeal Brief to address other errors in the examination. Applicants have not filed this Petition until now, as Applicants were attempting to have finality withdrawn through discussions with the Examiner. Specifically, Applicants raised the issue with the Examiner in a telephone interview held on May 18, 2009, in which the Examiner agreed to consider the request as part of Applicants' response to the rejections. However, it was not until issuance of the Advisory Action dated July 21, 2009 that Applicants learned of the Examiner's decision to maintain the rejection as final. As such,

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Applicants are submitting this Petition concurrently with a Notice of Appeal. As, the application is still pending, Applicants submit that this Petition is timely filed.

II. Grounds for Withdrawal of Finality

As grounds for this Petition, Applicants state as follows:

1. Section 706.07(a) of the MPEP specifies the conditions under which the finality of a second or subsequent Office action is proper, providing that: "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement...."
2. Applicants submit that the new ground of rejection introduced in the final Office Action dated January 26, 2009 was not necessitated by applicants' amendment.
 - a. The final Office Action rejects independent claim 6 and its dependent claims on new grounds. Specifically, the Office Action forewent earlier prior art rejections in favor of rejections in light of newly cited prior art in the final Office Action. While no reason is given in the Office Action for making the rejections final, the Examiner has subsequently alleged that Applicants amendment necessitated the new ground(s) of rejection presented in this Office action.
 - b. The sole amendment to the pending claims was made in an Amendment filed March 11, 2008. In that Amendment, Applicants cancelled original independent claim 1 and amended original dependent claim 6 to include all of the recitations of independent claim 1 verbatim. No language was added to claim 6 other than the verbatim language of claim 1 from which claim 6 depended. Further, the dependent claims were amended to depend from claim 6.

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- c. Claim 6 was previously presented for examination, as the claim is original to the application and was supposedly examined by the Examiner in the Office Action dated September 11, 2007.
- d. Applicants submit that because the recitations of amended claim 6 (embodying recitations from independent claim 1 and original claim 6) were presented for examination in the preceding Office Action, the new ground of rejection of claim 6 made in the final Office Action cannot reasonably be said to be necessitated by a claim amendment.

3. Applicants did not submit an Information Disclosure Statement (IDS) in the time period between the first and final rejections. As such, the final rejection cannot have been based on information submitted in an IDS.

III. Conclusion

The conditions set forth in § 706.07(a) of the MPEP have not been satisfied.

Accordingly, for that reason alone, as well as in the interests of fairness, the finality of the final Office Action should be withdrawn.

It is not believed that fees are required for filing of this Petition. However, if fees are required, such fees are hereby authorized to be charged to Deposit Account No. 13-4365.

Respectfully submitted,



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